

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

Claims 1-18 were pending in this application. In this response, no claims have been amended, canceled or added. Thus, claims 1-18 remain pending.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,948,889 to Arvidsson (hereafter "*Arvidsson*") on the grounds set forth at page 2 of the Official Action.

Arvidsson only qualifies as prior art under 102(e). The effective filing date of the present invention is January 28, 2005 because this application is a national stage entry of PCT/SE05/00104, which was filed on January 28, 2005. Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. 35 U.S.C. § 103(c). Applicants invoke the above provision and confirm that:

The subject matter of *Arvidsson* and the claimed invention, were at the time the claimed invention was made owned by or subject to an obligation of assignment to Sandvik AB.¹

Thus, *Arvidsson* does not qualify as prior art for purposes of rejection under 35 U.S.C. § 103.

¹ Subsequently, both USP 6,948,889 and the present application have been assigned to Sandvik Intellectual Property AB.

Even if *Arvidsson* did qualify as prior art for purposes of rejection under 35 U.S.C. § 103, the rejection is improper because the rejection has failed to establish a *prima facie* case of obviousness. At least one element of the claims are not taught in the cited reference. There is no reasoned statement explaining the basis for any modification of the cited references in support of an obviousness rejection of the claims as presently presented. Accordingly, the rejection is improper and should be withdrawn.

The Examiner has failed to provide a clear articulation of the reasons why *Arvidsson* renders the claimed invention obvious. The Examiner has used the rationale of combining prior art elements according to known methods to yield predictable results as described in MPEP 2143. However, to reject a claim based on this rationale, the Examiner must articulate 1) a finding that the prior art included each element claimed, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements; 2) finding that one of ordinary skill in the art could have combined the elements as claimed by known methods and each element merely performs the same function as it does separately; and 3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Not all of the elements claimed are found in the prior art. Claims 1, 2 and 7 require the limitation that “wherein the widths of two or more grooves positioned one after the other in a series in one of the connecting surfaces increase progressively from a first groove to a last groove in the series.” *Arvidsson* fails to describe this limitation. The Examiner has stated that *Arvidsson* “inherently suggests that the widths of two or more grooves positioned one after the other in a series in one of the connecting surfaces could increase progressively from a first groove to a last groove in the series.” The Examiner points to column 6, lines 13-18 for evidence

of this inherency. The section of *Arvidsson* cited by the Examiner suggests that the ridges and grooves may have varying curve shapes. This does not provide a suggestion that the widths of the grooves themselves would increase progressively from one groove to the next until the last groove of the series. Rather, the passage in *Arvidsson* discloses that ridges can have different curvatures. *See, e.g.*, Figs. 8-11. Also, note how the ridges in those figures appear to be of constant width.

Each element would not be performing the same function as before the combination. In *Arvidsson*, each groove and especially the groove furthest from the cutting edge provides alignment of the cutting tool to the basic body. In the claimed invention the first groove closest to the cutting edge determines the positioning of the cutting tool to the basic body. *See, e.g.*, p. 9, ll. 19-39. Therefore, the grooves other than the first groove closest to the cutting edge no longer perform the same function as before the combination.

There is no finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable. The Examiner has stated that forming grooves having progressively larger widths would predictably result in varied widths. However, Applicant has unpredictably determined that by increasing the widths of the grooves progressively from the cutting edge to the opposite edge the tool seat can be made with less strict tolerances and still position the cutting edge precisely. *See, e.g.*, p. 9, ll. 19-39.

Even if there was a proper suggestion and reason provided in *Arvidsson* and the prior art to suggest modifying the width, there is no basis for the claimed widths in a series increasing “progressively from a first groove to a last groove in the series” as claimed. Given the complete lack of such disclosure in *Arvidsson*, any attempt to modify or find inherent in the disclosure to arrive at such a feature could only come from hindsight and not from any teaching or suggestion

in the references themselves or any other source. This is clearly improper. Withdrawal of the rejection as to claims 1, 2, and 7 is respectfully requested.

Dependent claims 3-6 and 8-18 are also not obvious for at least the same reasons as for claims 1, 2 and 7 from which they depend. Withdrawal of the rejection as to claims 3-6 and 8-18 are respectfully requested.

Claims 3-5, 8-11, and 13-17 are not obvious for at least the additional reason that the claims further define the width enlargement. *Arvidsson* fails to suggest any width enlargement for the reasons presented above, much less specific dimensions of the enlargement. The Examiner alleges that the specific width enlargements claimed would have been an obvious matter of design choice because the width enlargement is merely a change in size. The Examiner must articulate reasons with rational underpinning to support legal conclusions of obviousness, not mere conclusory statements. *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006); MPEP § 2142. The Examiner provides no factual support for the conclusion that it would be obvious to form the tool part having the claimed features. In contrast, the factual evidence points to the claimed features being non-obvious. *Arvidsson* has no disclosure of such a feature and Applicants have discovered that the claimed progressive width enlargement, allows precise alignment of the cutting edge of the tool part, with less strict tolerances, which allow the part to be made without cost-demanding, extraordinary machining operations. *See, e.g.*, p. 9, ll. 19-39. Therefore, the Examiner fails to establish a *prima facie* case of obviousness for claims 3-5, 8-11, and 13-17 for at least this additional reason.

The Examiner has further attempted to rely on *In re Rose*, 220 F.2d 459, 105 U.S.P.Q. 237 (C.C.P.A. 1955) to support obviousness of claims 3-5, 8-11, and 13-17. Legal precedent can only provide rationale supporting obviousness if the facts in the case are sufficiently similar to

those in the application. *See* MPEP 2144 III. *In re Rose* relates to the obviousness of merely changing proportions of the same invention without changing the specific dimensions and functionality of the invention. In contrast, the modification proffered by the Examiner would entail changing the individual widths between ridges progressively from the cutting edge to the opposite edge of the connecting surface to produce a tool part that can align precisely with less tolerances required in machining the part; features absent from the cited reference. The present invention changes specific dimensions within the invention, not merely sizing up the same proportions, and the functionality of the invention is affected. The facts in this application are not sufficiently similar to those in *Rose*. Thus the rejection's reliance on *Rose* is improper for at least this additional reason and should be withdrawn.

Claims 6, 12, and 18 are not obvious for at least the additional reason that the claims recite "wherein said first groove in the series of grooves is located closest to a free edge along the insert seat." *Arvidsson* fails to suggest that limitation. The Examiner has attempted to rely on *In re Japikse*, 181 F.2d 1019, 86 U.S.P.Q. 70 (C.C.P.A. 1975) to support obviousness of rearranging parts. However, for the reasons provided above *Arvidsson* fails to teach any progressive width enlargement to rearrange. Further, legal precedent can only provide rationale supporting obviousness if the facts in the case are sufficiently similar to those in the application. *See* MPEP 2144 III. *In re Japikse* relates to changing the position of a switch without modifying the operation of the device. In contrast, Applicant's tool part aligns at the ridge closest to the cutting edge as opposed to the ridge furthest from the cutting edge, thereby modifying the operation of the device. *See, e.g.*, p. 3, ll. 1-23 and p. 9, ll. 19-39. The present invention progressively widens the space between ridges, with the smallest gap at the ridge closest to the cutting edge to allow the tool part to align precisely with a lower tolerance required during

manufacturing of the tool part. *See, e.g.*, p. 9, ll. 19-39. Placing the smallest width at the ridge closest to the cutting edge is not a mere rearrangement of parts, and the facts in this application are not sufficiently similar to those in *Japikse*. Thus the rejection is improper for at least this additional reason and should be withdrawn.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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